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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,587	10/07/2003	Thomas L. Barnhart	170707-1016	6858

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EXAMINER	
JANVIER, JEAN D	

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
08/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/681,587	BARNHART ET AL.	
	Examiner	Art Unit	
	JEAN JANVIER	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *04/21/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/11/09 has been entered and a Non-Final Action follows.

Response to Applicant's Arguments

First, upon reviewing the inventor's ("132") Affidavit, it appears that there is no uncontradicted "unequivocal" declaration or clear statement disqualifying the Ray's article (FASTBALL.com's Decode & Win Game) as a prior art reference. Further, although the subject matter in the present Application was jointly invented, as seen in the parent applications, by both Mr. Joel Brooks and Mr. Barnhart, however, it appears that Mr. Barnhart did not sign the present Affidavit (See MPEP 716.10). Thus, for the above reasons, the Affidavit appears to be inadequate and the article may still be used as prior art.

DETAILED ACTION

Specification

Claim Status

Claims 1-8 are pending in the Instant Application.

Double Patenting

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, and 7 of the Instant Application Serial No. 10/681,587 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of USP 6,629,888 (to Barnhart) respectively. Although the conflicting claims are not identical, however, they are not patentably distinct from each other because of the following reasons:

For example, claim 1 of the Instant Application Serial No. 10/681,587 substantially recites the limitations of claim1 of USP 6,629,888. Here, as shown in comparison table 1 below, claim 1 of the Application adds the underlined limitations, which are missing from patented claim 1.

Application Serial NO. 10/681,587 Claim 1	**USP 6,629,688** Claim 1
1. (currently amended) A method for increasing web site traffic using a computer comprising: (a) providing a web site at which a game is played or at which a sweepstakes is entered or at which a product promotion is being conducted in which said game or sweepstakes or product promotion involves exposing a hidden image; and (b) providing a game piece to at least one individual, wherein said individual interacts with said web site with said game piece wherein said game piece includes a selectively camouflaged image **covered by a dull coating that reduces at least one of the reflectivity of a substrate of the game piece and the contrast between the substrate and the camouflaged image**, and wherein said individual places said game piece in proximity to a light source of said computer to reveal said selectively camouflaged image to determine a winning status of said game piece.	1. A method for increasing web site traffic using a computer comprising: providing a game piece to at least one individual; and providing a web site, wherein the individual interacts with the web site with the game piece; wherein the game piece includes a selectively camouflaged image; and wherein the individual places the game piece in proximity to a light source of said computer to reveal the selectively camouflaged image to determine a winning status of the game piece.

comparison Table 1

Although the patented claim (claim 1) omits the above underlined limitations, however, as per Applicant's own admission (APA), it is common practice in the art to use "dull coating" to enhance the appearance and durability of printed matter (See at least the background of the specification). Furthermore, it is customary in the art to obscure

certain elements or objects by chromatic camouflage and a decoder, having a chromatic filter, may be used to view the obscured elements or objects (US 5,401, 032 to Barnhart))

Thus, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to add a "coating" or "dull coating" step to patented claim 1 so as to obscure the game piece image and apply a coating thereon that prevents associated printed characters from being smudged or smeared.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray, Debra, in an article "**FASTBALL.com's" "Decode & Win Game**" ", published on

November 1997 (Dialog 01539026 01-90014).

As per claims 1-8, Ms. Ray describes, in the article, that FASTBALL.com's Decode & Win Game proved that a compelling promotion can not only generate trial, but also bring repeat visitors or players to an online service or website **in order to increase traffic at the said web site (reading on the step of providing a website at which a game is being played, a product promotion is being conducted....).**

Further, in the article, Ms. Ray continues by pointing out that the marketing dilemma of the 1990s was: How can producers of a new Internet Web site get people or visitors to try it or to visit it to thereby increase traffic at the said website? (Same problem as the one this Application is trying to solve). Here, to address this problem or dilemma, Cox Interactive Media's FASTBALL.com had completed a four-week promotion that set new benchmarks for on-line/Internet promotions.

In fact, a direct mail campaign to a test cell of 7,000 FASTBALL.com users generated had interest or participation in excess of 40 percent (increasing traffic at the featured site by 40 percent). Compared to national direct mail response rates that usually average in the one to five percent range, FASTBALL.com's "Decode & Win Game" promotion had proved that a compelling (product) promotion can not only generate trial or interest, but also bring repeat visitors to an on-line service (website). In general, the direct had invited the visitors (site users) or potential players to visit the website and participate in a promotional game (sweepstakes entry) by using a provided game indicia (game piece).

About the Game:

Indeed, "The Promotions Unlimited, Inc.", an Atlanta-based sales promotion

agency, had developed the "Decode & Win Game," in conjunction with Cox Interactive Media, using a patent-pending decoder device (game device) delivered through a direct mail campaign. The direct mail piece was sent to a test cell of 7,000 FASTBALL.com users throughout the country (providing a game piece to the users). The mailing directed consumers to a special contest page within the domain of the FASTBALL.com on-line service (the communication or direct mail invited the users to visit the featured site and participate in a contest using the received or provided game piece). The Grand Prize for the "Decode & Win Game" or contest was a trip for two to any of the six newest baseball stadiums in the U.S. Other prizes included baseball memorabilia.

The FASTBALL.com "Decode & Win Game" **piece contained a hidden word** (camouflaged image), which was not visible without assistance (which cannot be decoded without special means). To decode the hidden word or to reveal the camouflaged image imprinted on the game piece, players or individuals interacted with the featured website when placing their game piece against a specially colored background (lit background) appearing in the FASTBALL.com/contest page to reveal the winning status of the game piece (placing the game piece in proximity of a light source or colored background to reveal the winning status of a game piece).

In addition, each game piece contained a unique account number to identify individual players and keep track of the number of times they visited the site (a game piece is unique). To participate, players entered their account numbers.

Each week for four weeks, a different word was selected as the winner. Players were asked to enter each week for four weeks.

Participants in the FASTBALL.com promotion played an average of 2.1 times during

the four-week period, with many returning each of the four weeks during the contest (reasonable achievement).

Finally, the next step in the program requires FASTBALL.com to recruit sponsors for the national rollout of the "Decode & Win Game." In addition to direct mail, the national contest could be delivered through consumer print media, in-pack, on-pack, over-the-counter and at point-of-purchase (delivering contest invitation to potential users via a plurality of media).

As per claims 1 and 7, the article does not expressly disclose covering the game piece camouflaged image with a coating or "dull coating".

However, as per Applicant's own admission (APA), it is common practice in the art to use "dull coating" to enhance the appearance and durability of printed matter (See at least the background of the specification). Furthermore, it is customary in the art to obscure certain elements or objects by chromatic camouflage and a decoder, having a chromatic filter, may be used to view the obscured elements or objects (US 5,401, 032 to Barnhart))

Thus, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to cover the game piece camouflaged image with a "coating" or "dull coating" so as to further obscure the game piece image, while preventing associated characters imprinted thereon from being smudged or smeared.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 6,120,062 to Revill discloses a sales receipt for displaying transaction and/or advertising indicia. The sales receipt consists of a coated plastic film with one or more layers. The surfaces of the plastic film may be treated and coated so that they can be provided with printed characters that will not smudge or smear (See abstract).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571)272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

06/21/09

/.J.J./

/Jean D. Janvier/

Primary Examiner, Art Unit 3622